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09/716,042	11/17/2000	Robert D. Briggs	PA000456	7621

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT PAPER NUMBER

2683

DATE MAILED: 07/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/716,042

Applicant(s)

BRIGGS ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 8-19, 21-23 and 25-27 rejected under 35 U.S.C. 102(e) as being anticipated by Jansen et al. US 6,243,450 (hereafter Jansen).

As per **claims 1, 8, 14, 17, 21 and 25**, Jansen teaches a method to invoice users (title is "pay-per use") for information accessed using a communication network comprising:

Placing a first location in communication with a remote second location (figures 1 and 2 show the Kiosk being connected to a remote computer/building)

Transferring information having at least one associated cost from second to first location, wherein transfer occurs prior to payment of the at least one associated cost being made for the information (figure 10, #254 shows payment method can be PRE-PAY, POST-PAY or FREE)

Debiting the first location for the selected information after the information is transferred (figure 10, #300, 302, 304 and 306 calculating cost of the transfer and submitting usage record to database and receipt being printed, also C10, L23-32, specifically L28-32).

With further regard to claim 8, Jansen teaches the ability to view, download and print many different types of information (C1, L45-63, specifically L62-63).

With further regard to claim 14, Jansen teaches communicating all costs from the first location to an invoicing location, generating an invoice and communicating the invoice to a party responsible for the satisfaction of the invoice (figure 4 shows a credit card reader and printer to print invoice/receipt, and figure 10 shows pay-for-use service #304 and print receipt #306 which is for the user).

With further regard to claim 17 and 21, Jansen teaches a computer which has storage (figure 1, #14) which reads on digital signal processing (DSP) unit and storage unit coupled to the DSP unit.

With further regard to claim 25, Jansen teaches an article of manufacture (figure 1 Kiosk and network shown in figure 2) embodying machine-readable instructions (figure 1, #14 is a computer executing code/instructions).

As per **claims 2, 9, 18, 22 and 26**, Jansen teaches claim 1/8/17/21 further comprising:

Recording associated costs at the first location

Communicating recorded costs from first location to an invoice location (figure 1 shows a Kiosk containing a computer processor, #14 which is further detailed in figure 4. Figure 2 shows a central server, #26 which is further detailed in figure 3. Both figures contain computers which are known in the art as being capable of recording/storing data on the processor and can communicate via comm. links shown in figure 1, #24/28. Figure 3 shows a database, #62 that contains billing records – these records can be recorded at either the Kiosk and/or at the central computer).

As per **claims 3, 10, 19, 23 and 27**, Jansen teaches claim 2/8/18/22 further comprising communicating a debit charge from the second location to the invoicing location after the selected information is transferred (C3, L15-61, specifically L38 teaches a credit card reader to allow the user to be debited at the first location which is transferred through the central computer of figure 2 to a credit card company. One skilled in the art would provide for the debiting to be supported anywhere in the system).

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As per **claim 11**, Jansen teaches claim 10, further comprising a wireless communication device (C3, L35-38).

As per **claim 12**, Jansen teaches claim 11, further comprising connecting first and second locations via the Internet (figure 2, #40 shows connectivity to the Internet)

As per **claim 13**, Jansen teaches claim 12 wherein the selected information is an application program (abstract teaches receiving a "file" and C1, L62 teaches Internet access which can provide download of programs via FTP, etc.). The examiner interprets any downloading of generic files as reading on an application program download as well.

As per **claim 15**, Jansen teaches claim 14 wherein the another at least one associated cost is zero, wherein the copy of the designated information has an each-use associated cost, and wherein the each-use associated cost is incurred each time the designated information is used (abstract teaches "cost-per-unit-time" and a usage cost based on "time" and "information in file").

As per **claim 16**, Jansen teaches claim 15 wherein the copy of the designated information is used at the first location (figure 1 shows data downloaded to Kiosk).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7, 20, 24 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Jansen further in view of Rieken US 6,009,154 (hereafter Rieken).

As per **claims 4, 20, 24 and 28**, Jansen teaches claim 3/19/23, further comprising:

Generating an invoice (figure 10, 300-306)

Communicating the invoice to a party responsible for satisfaction of the invoice (figure 10, #306 generates invoice/receipt for user at Kiosk)

But is silent on Comparing the recorded debits from the first location with the debits from the second location,

Rieken teaches flexible rate charging (figure 2) that involves negotiation between the user (eg. first location) and the service provider (eg. second location) for billing purposes. The examiner interprets this as reading on the claimed limitation of "comparing debits from first location with the debits from the second location". In essence, this can be viewed as an error-checking function and/or a way of gaining agreement from both users/ends (ie. on the price to be charged, on the amount of data downloaded, etc.).

It would have been obvious to one skilled in the art at the time of the invention to modify Jansen, such that checking/comparing is performed, to ensure that errors do not occur between the two end users/systems.

As per **claim 5**, Jansen teaches claim 4 further comprising a wireless communication device (C3, L35-38).

As per **claim 6**, Jansen teaches claim 5 further comprising connecting first and second locations via the Internet (figure 2, #40 shows connectivity to the Internet)

As per **claim 7**, Jansen teaches claim 6, further comprising at least one cost for information access and one for each-use (title is "pay-per use", abstract and C2, L13-42).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Motahashi et al. US 5,946,670 teaches data switch charging/billing.
2. Felger US 6,553,108 teaches billing for computer session.
3. Benyacar US 5,003,584 teaches billing of value-added calls.
4. Ronen US 5,845,267 teaches billing for Internet transactions from Intranet.
5. Russo US 5,619,247 teaches stored program pay-per-play.
6. Biggs Jr. et al. US 5,475,740 teaches paying for amenities via phone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-746-7493 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist on 703-306-0377.

SMD/20